

REMARKS

Status of the Pending Claims

Claims 1, 3-5, 7, 8, 32, 33, 35, 38, 43, 44, 46, 48-50, and 54 are currently rejected under 35 U.S.C. §102(b) as being anticipated by Hopkins, Jr. , U.S. Patent No. 4,513,545 (hereinafter "Hopkins, Jr.").

Claims 2, 6, 9, 10, 12-19, 45, and 47 are currently rejected under 35 U.S.C. §103(a) as being unpatentable over Hopkins, Jr.

Claims 20-24 are currently rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts, U.S. Patent No. 6,164,035 (hereinafter "Roberts").

Claims 25-31 are currently rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts in view of the publication: Mechanical and Electrical Equipment for Buildings, by Benjamin Stein, et al., 2000, John Wiley & Sons, Inc., 9, 415, 695 (hereinafter "Stein").

Claims 36, 36, and 39-42 are currently rejected under 35 U.S.C. §103(a) as being unpatentable over Hopkins, Jr. in view of Stein.

Claim 51 is currently rejected under 35 U.S.C. §103(a) as being unpatentable over Hopkins, Jr. in view of Borges, U.S. Patent No. 4,655,011 (hereinafter "Borges").

Claim 52 is currently rejected under 35 U.S.C. §103(a) as being unpatentable over Hopkins, Jr. in view of Roberts.

Remarks

Applicant objects to the Examiner's rejections under 35 U.S.C. §102 to the extent they fail to accurately specify or identify the portions or features of Hopkins, Jr. that purportedly

anticipate the pending claim limitations. Though the Examiner refers to features of Hopkins, Jr. using letters (e.g. A, B, C), the Applicant cannot determine what is being referred to since Hopkins, Jr. uses numerals in referencing the drawings. Accordingly, Applicant is forced to speculate and is unable to properly respond to the Examiner's contentions. Applicant requests, therefore, that these rejections be withdrawn. *See e.g., Ex parte Gambogi*, 62 U.S.P.Q.2d 1209, 1212 (Bd.Pat.App & Interf. 2001) ("Rejection of claims in patent application...must be vacated and remanded, since patent examiner...has not referred to specific portions of...cited [reference], and since rejection therefore requires both applicants and Board of Patent Appeals and Interferences to speculate....")

Applicant also objects to the Examiner's rejections in the Office Action to the extent they fail to present a *prima facie* case of obviousness under 35 U.S.C. §103. For example, on pages 3-4 of the Office Action the Examiner states as follows:

Regarding claims 2, 6, Hopkins, Jr. shows that basic claimed structure. Hopkins, Jr. does not show compliance with Building standards or sufficient material strength. *It would have been an obvious design choice to comply with building standards and have sufficient material strength since this would enable the invention to be erected commercially.* (emphasis added).

* * * * *

Regarding claims 12-19, the claimed methods are the obvious methods if using Hopkins, Jr.'s apparatus for and method of constructing transporting and erecting a structure of two or more stories comprised of a plurality of prefabricated core modules and panelized room elements.

In each of these instances, the Examiner fails to make reference to prior art that singly or collectively discloses **all of the claimed elements**. For example, regarding claims 2 and 6 the Examiner does not refer to any prior art that discloses "compliance with building standards" (claim 2) or a "load bearing structure" (claim 6), much less prior art that teaches or suggests the modification of Hopkins, Jr. to include these limitations. The same is true for Claims 12-19: not

a single reference is provided that teaches or suggests “preparing a **pre-existing building** to accommodate at least one prefabricated construction panel.” Indeed, nowhere in the Office Action is it acknowledged that the invention allows for attachment of the construction panels to pre-existing buildings. The Examiner’s failure to do so renders these (and other) obviousness rejections improper. *See e.g.*, MPEP §2143.03; *In re Royka*, 490 F.2d 981 (CCPA 1970) (To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”) Applicant respectfully requests, therefore, that these and other similarly deficient rejections be withdrawn.

Although Applicant does not agree with the pending rejections, Applicant has further amended the claims to clarify several differences between the present invention and the systems and methods described in the prior art references. Specifically, claims 1, 12, 20, 26, 32, 39, and 43 have been amended to recite a construction panel “for defining **a portion** of a building wall, pitched roof, ceiling, flat roof, or some combination thereof.” This amendment captures one aspect of the invention, namely, the provision of a small, lightweight panel that can interlock with similar panel(s) (and/or a pre-existing building) to form at least **a portion** of a building wall, pitched roof, ceiling, flat roof, or some combination thereof.

In contrast, Hopkins, Jr. merely discloses “modular cores” that are stacked on top of each other to form multi-level dwellings or structures:

As illustrated in FIG. 1, the prefabricated lower core module 1 is set in place for example, by means of a lightweight crane (not shown), at the building site laterally preformed slab depression 3 of a formed monolithic concrete slab 2 and recesses. The middle core module 4 is then stacked vertically above the lower core module 3 as shown in FIG. 2.

See, Hopkins, Jr., Col. 6, lines 37-44. Figures 1-3 of Hopkins, Jr. illustrate how these “modular cores” are stacked on top of each other to form a multi-level structure. Figure 15 further demonstrates how these “modular cores” are not panels, but rather whole, uniform structures that form an entire floor or level of a multiple-level dwelling. The “frames” at the heart of modular cores 1, 4, and 6 make this evident.¹

Claims 1 and 12 were further amended to recite that “construction panel” includes “at least one fastener for attaching the construction panel to at least one of an adjacent construction panel and a pre-existing structure(s).” Applicant agrees with the Examiner that “Hopkins, Jr. does not show plates and fasteners.” *See*, Office Action, Page 4, lines 6-7. Further, Applicant respectfully submits that none of the cited prior art references disclose -- singly or collectively -- attachment of a “construction panel” to “at least one pre-existing structure,” as claimed by the present invention. Hopkins, Jr., for example, merely discloses “modular cores” to which “wall elements” may be attached. However, Hopkins, Jr. does not teach or suggest attaching said modular cores or wall elements to a pre-existing structure in the way claimed by the present invention. The remaining cited references fail to overcome Hopkins, Jr.’s deficiencies.

Claim 20 was also amended to recite that the construction panel containing the wire-based subsystem is “attached to at least one pre-existing structure.” In contrast, Roberts -- the lone reference relied on in support of the rejection -- merely discloses “foam walls” that include internal vertical passageways for guiding wall support elements. Roberts does not, however,

¹ The individual “wall elements” (e.g., #11 in Figure 4) disclosed in Hopkins, Jr. are distinguishable from the “construction panels” of the present invention in that they constitute an entire wall, whereas the claimed “construction panels” of the present invention may interlock to form a portion of a wall, roof, ceiling and/or floor, for example. Further, the wall elements do not interlock with a pre-existing structure.

teach or suggest attaching block wall 10 to a pre-existing building structure as required by amended claim 20. Moreover, the junction box 54 disclosed by Roberts -- and relied on by the Examiner in support of the rejection -- is not "integrated" into block wall 10 as expressly required by claim 20.² Rather, it is placed in an indentation that runs along the inner wall of block wall 10. *See* Figure 1, Roberts patent. The remaining cited references fail to overcome Roberts's deficiencies.

Accordingly, in view of the above amendments and remarks, Applicant submits that independent claims 1, 12, 20, 26, 32, 39, and 43, as amended, are allowed over the art of record. Each remaining claim depends from either independent claim 1, 12, 20, 26, 32, 39, or 43, and is therefore allowable over the art of record for at least the reasons set forth above.

² The wire sub-systems of the present invention are contained within and without the claimed construction panels. *See*, Figure 25, and Pages 34-45.

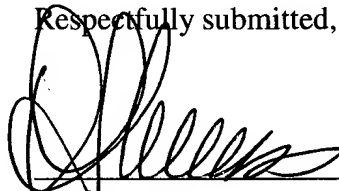
CONCLUSION

The Office Action, references and rejections have been duly considered by the Applicant and addressed by the foregoing amendments and remarks. Reconsideration of the application and allowance are respectfully solicited.

Should the Examiner however require resolution of any issues for allowance, the Examiner is invited to contact the undersigned to expedite the same. Any fees that may be due but not attached, or overpayment of any fees, may be charged or credited to Deposit Account No. 50-0206.

Respectfully submitted,

By:



Ozzie A. Farres
Registration No. 43,606

HUNTON & WILLIAMS, LLP
1900 K Street, NW
Washington, D.C. 20006
(202) 955-1500

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